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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/552,088 | 04/19/2000 | Elliott D. Light | 12307/100130 | 4158 |

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| EXAMINER | |
|---|---|
| ELISCA, PIERRE E | |
| **ART UNIT** | **PAPER NUMBER** |
| 3621 | |

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/552,088 | LIGHT ET AL. | |
| | Examiner | Art Unit | |
| | Pierre E. Elisca | 3621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-50 and 129-148* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-50, and 129-148* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This office action is in response to Applicant's response, filed on 10/29/2004.

2. Claims 1-50 and 129-148 are pending.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 2 and 8-50 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Clark et al. (U.S. Pat. No. 5,890,140) and Rogge et al (U.S. pat. No. 5,500,890) in view of Edwards et al US 2001/0037319 A1.

**As per claim 1, Clark** substantially discloses an electronic delivery system that integrates a plurality of financial services which is equivalent to Applicant's claimed invention wherein said a system for data recipient electronic transactions comprising:

a first network (see., abstract, fig 1); and

a second network (see., abstract, fig 1); and

at least one data recipient computer associated with at least one data recipient and connected to the first network, wherein the at least one data recipient computer further comprises web server software for hosting a web page and executing client software for

allowing the at least one data recipient to send and receive information over the first network (see., abstract, fig 1); and

at least one gateway computer connected to the first network and a second network, the at least one gateway computer having gateway software for allowing the file exchange between the first and second networks (see., abstract, fig 1, securities);

at least one data subject network communication device (Internet) associated with at least one data subject and connected to the second network, wherein the at least one data subject having software for accessing and communicating over the second network to the gateway computer to send and receive information over the first network (see., fig 15, col 20, lines 65-67, col 21, lines 1-60);

at least one data repository (fig 1, element 11) connected to the first network, the at least one data repository having data repository (see., fig 15, col 20, lines 65-67, col 21, lines 1-60, gateway or securities, col 14, lines 14-21). It is to be noted that Clark fails to disclose that the client software includes instructions for forwarding data to the gateway computer, the second network. However, Rogge discloses a second network or virtual network and a network software or NCD software (see., col 6, lines 31-40, col 9, lines 1-11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic delivery of Clark by including a second network and a network software or NCD software because such modification would provide an electronic delivery system with high degree of access control for improved security.

During the interview conducted on 10/30/2003, Applicant's representative argued that the prior art of record (Clark 140" and Rogge 890") fail to disclose: " in response to the offer, determining an identity of a data subject based on the message". However, the newly found prior art Edwards discloses a content brokering system that assists the negotiations between a buyer and seller through a financial function. The seller sends an offer to the content brokering system addressed to the buyer as a private message that is forwarded by the content brokering system. The offer may content a sample of the content so the buyer can determine if the content is what is wanted (or determining identity of a data subject based on the message) see., abstract, pages 2 and 3, fig 1B. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Clark and Rogge by including the limitation detailed above as taught by Edwards because this would prevent against unauthorized use of the sample in the offer.

**As per claim 2, Clark** discloses the claimed limitation, wherein the data repository further comprises instructions to send the purchasing information to the at least one data recipient computer (see., fig 1, element 11, col 4, lines 50-67, col 5, lines 1-54).

**As per claims 8-50 Clark** discloses an electronic delivery system that integrates a plurality of financial services which is equivalent to Applicant's claimed invention

wherein said a method for purchasing an item over a first network coupled to a second network, comprising the steps of:

at a data recipient computer connected to the first network (see., abstract, fig 1); and

receiving a request from a data subject network communications device connected to the second network (see., abstract, fig 1); and

in response to the request, sending a data file from the data recipient computer to the data subject network communications device (or Internet); and at a data repository (element 11 of Fig 1) connected to the first network (see., abstract, fig 1); and

gathering payment data associated with the data subject based on the identity (see., abstract, fig 1, securities or gateway);

presenting the data subject network communications device, receiving a purchase decision from the data subject network communications device, and sending payment data to the data recipient computer (see., fig 15, col 20, lines 65-67, col 21, lines 1-60, fig 15, col 20, lines 65-67, col 21, lines 1-60, gateway or securities, col 14, lines 14-21).

During the interview conducted on 10/30/2003, Applicant's representative argued that the prior art of record (Clark 140" and Rogge 890") fail to disclose: " in response to the offer, determining an identity of a data subject based on the message". However, the newly found prior art Edwards discloses a content brokering system that assists the negotiations between a buyer and seller through a financial function. The seller sends an offer to the content brokering system addressed to the buyer as a private message that is forwarded by the content brokering system. The offer may content a sample of the content so the buyer can determine if the content is what is wanted (or determining

identity of a data subject based on the message) see., abstract, pages 2 and 3, fig 1B. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Clark and Rogge by including the limitation detailed above as taught by Edwards because this would prevent against unauthorized use of the sample in the offer.

5. Claims 3-5 and 6-7 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Clark et al. (U.S. Pat. No. 5,890,140) and Rogge et al. And Edwards, and further in view of Official notice.

**As per claims 3-5 and 6-7 Clark, Rogge, and Edwards** discloses the claimed limitation as stated in claim 1 above, but they fail to teach the steps of consisting of the Internet, LANS, WANS, Wireless and cable networks. However, Examiner hereby takes Official notice that LANS, WANS, wireless or cell, cable networks , HTML, XML, and WNL are notoriously well-known in the art, and therefore, it would have been obvious to a person of ordinary skill in the art to modify the article of manufacture of **Clark** by including LANS, WANS, wireless or cell, and cable networks because LAN, WAN are geographic area equivalent to a standard metropolitan statistical that shared transmission medium and packet broadcasting and wireless and cable networks are way of communications (i.e satellite or coaxial cable or order means of communications).

6. Claims 129-148 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Clark et al. (U.S. Pat. No. 5,890,140) in view of Edwards et al US 2001/0037319 A1.

**As per claims 129-148 Clark** substantially discloses an electronic delivery system that integrates a plurality of financial services which is equivalent to Applicant's claimed invention wherein said a method for purchasing an item over a first network coupled to a second network, comprising the steps of:

at a data recipient computer connected to the first network (see., abstract, fig 1); and

receiving a request from a data subject network communications device connected to the second network (see., abstract, fig 1); and

in response to the request; sending a data file from the data recipient computer to the data subject network communications device (or Internet); and at a data repository (element 11 of Fig 1) connected to the first network (see., abstract, fig 1); and

gathering payment data associated with the data subject based on the identity (see., abstract, fig 1, securities or gateway);

presenting the data subject network communications device, receiving a purchase decision from the data subject network communications device, and sending payment data to the data recipient computer (see., fig 15, col 20, lines 65-67, col 21, lines 1-60, fig 15, col 20, lines 65-67, col 21, lines 1-60, gateway or securities, col 14, lines 14-21).

On 10/30/2003, Applicant's representative argued that the prior art of record (Clark 140" and Rogge 890") fail to disclose: " in response to the offer, determining an identity of a data subject based on the message". However, the newly found prior art Edwards discloses a content brokering system that assists the negotiations between a buyer and

seller through a financial function. The seller sends an offer to the content brokering system addressed to the buyer as a private message that is forwarded by the content brokering system. The offer may content a sample of the content so the buyer can determine if the content is what is wanted (or determining identity of a data subject based on the message) see., abstract, pages 2 and 3, fig 1B. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic delivery system of Clark by including the limitation detailed above as taught by Edwards because this would prevent against unauthorized use of the sample in the offer.

***Response to Arguments***

7. Applicant's arguments filed 10/29/2004 have been fully considered but they are not persuasive.

REMARKS

8. In response to Applicant's arguments, Applicant argues that Clark does not include two networks. As indicated above, Clark fails to disclose that the client software includes instructions for forwarding data to the gateway computer, the second network. However, Rogge discloses a **second network** or virtual network and a network software or NCD software (see., col 6, lines 31-40, col 9, lines 1-11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic delivery of Clark by including a second network and a

network software or NCD software because such modification would provide an electronic delivery system with high degree of access control for improved security.

b. "Applicant also maintains that Clark and Rogge cannot be combined, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071,5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App & Inter); and Es parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

c. "web server software for hosting a web page". However, the Examiner respectfully disagrees with this assertion since Clark discloses this limitation in fig 29, col 26, lines 5-65, specifically workstations 12.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Pierre Eddy Elisca**

**Primary Patent Examiner**

**January 12, 2005**